

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Patent Application of:  
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Petitions Examiner: David Bucci

**PETITION TO HAVE 3<sup>rd</sup> PARTY PETITION TO SUSPEND UNDER 37 CFR 1.183 AND  
OPPOSITION TO APPLICANT'S REQUEST FOR RECONSIDERATION BE EXPUNGED**

MS Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a Request that the "NON-PARTY DENSO'S PETITION TO SUSPEND THE RULES UNDER 37 C.F.R. §1.183 AND OPPOSITION TO REQUEST FOR RECONSIDERATION OF DISMISSAL OF PETITION UNDER 37 C.F.R. § 1.53(b) and/or § 1.182 FOR GRANT OF A FILING DATE AND AMENDMENT OF APPLICATION" (hereafter "Opposition") filed on or about January 06, 2009 by Paul R. Steadman of the firm of Kirkland & Ellis LLP be expunged from the file of the present application, for the reasons given below.

It is first noted that this is the second attempt by a third party to improperly insinuate itself into the filing date petitions filed in this case. The previous third party Opposition was expunged from this file, upon written petition by applicant. Because that petition included a rather detailed analysis of the Opposition, applicants requested that its own petition likewise be expunged to free the record from inaccurate, misleading, and prejudicial arguments. In this instance, however, applicant does not wish to elevate in any way the second Opposition to a document worthy of further notice by analyzing its errors in a detailed manner. Applicant further desires that the instant petition remain in the record, to hopefully deter any further third party "Oppositions," or any other unwarranted third party intrusions. However, applicant respectfully requests that this latest "Opposition" likewise be expunged from the record of this file, for the reasons below.

Clearly, the instant third party is in no position to have direct knowledge of the cause of any filing date issue, or the attendant facts. As such, the governing regulation itself fails to provide any basis for the third party's attempt to turn this *ex parte* matter into an *inter partes* proceeding under the guise of a petition under 37 C.F.R. § 1.183. The third party was not involved in the filing of the above-captioned application. The third party cannot supply any evidence or factual information to be considered in addition to that already supplied by the applicant, and cannot supply any specialized expertise (that the USPTO does not itself possess) in the evaluation of this or any petition filed under 37 C.F.R. § 1.53(b).

The third party apparently recognizes its fatal lack of any standing where it seeks to obtain extraordinary relief under 37 C.F.R. § 1.183, in order to have the USPTO elevate the third party to the same status as that of the applicant before the USPTO. While it is well settled that a third party lacks standing to request extraordinary relief in this matter, it is equally well settled that 37 C.F.R. § 1.183 is not a mechanism for avoiding the established regulations and procedures of the

USPTO. *See Hicks v. Costello*, 1903 Dec. Comm'r Pat. 123, 125 (1903). The third party in this case has no special expertise in the application and enforcement of the particular statutory and regulatory provisions concerning patent law. Thus, the third party petition should be refused out of hand so as to permit this *ex parte* matter under 37 C.F.R. § 1.53(b) to proceed undisturbed between the applicant and the USPTO.

The latest Opposition filed on or about January 06, 2009 by Paul Steadman was also filed without the authority required under 37 C.F.R. §1.33 or §1.34. In fact, the first Opposition, as the instant Opposition, is simply a prejudicial document improperly filed in an *ex parte* proceeding by now a total of two parties, neither having any standing in these proceedings.

The most recent third party petition again seeks an unwelcome and unwarranted intrusion into the *ex parte* treatment of an application. Specifically, an application filed under the provisions of 37 CFR 1.53(b) is solely an *ex parte* proceeding and is strictly a matter between the applicant and the USPTO.<sup>1</sup> The Opposition candidly admits that it is a “non-party” and has no ownership interest in the present application. As such, this Petition will not attempt to respond point by point to the

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<sup>1</sup> A mere assertion of a right to have the Office act in accordance with the statutes and regulations does not confer standing upon a third party. *Boeing Company v. Commissioner of Patents and Trademarks*, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988). Further, a third party does not have standing to challenge Office decisions made *ex parte*. *See, e.g., Godtfredsen v. Banner*, 503 F.Supp 642, 647, 207 USPQ 202, 207 (D.D.C. 1980), *Syntex v. United States Patent and Trademark Office*, 882 F.2d 1570, 1574-1575, 11 USPQ2d 1866, 1870 (Fed. Cir. 1989), *Hitachi Metals Ltd. v. Quigg*, 776 F.Supp 3, 20 USPQ2d 1920 (Fed. Cir. 1989). There is nothing in the patent statutes which gives rise to a right in nonapplicants to object to the way in which patent applications of others are treated by the Patent and Trademark Office. A third party has no right to intervene in a particular patent application, *Animal Defense Fund v. Quigg*, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991), much less in a particular patent. *Hallmark Cards, Inc. v. Lehman*, 959 F. Supp. 539, 42 USPQ2d 1134 (D.D.C. 1997). Rather, any third party complaints concerning the USPTO's action(s) with respect to this patent must await an infringement action by the patentee against such third party. *Hallmark*, at 544, 42 USPQ2d at 1139; *cf. Laerdal Medical Corp. v. Ambu, Inc.*, 877 F.Supp. 255, 34 USPQ2d 1140 (D. Md. 1995).

baseless contentions made in the Opposition. Rather, this petition points out that the Opposition was improperly filed in an *ex parte* proceeding by a third party not entitled to participate in such proceedings, and therefore should be expunged.

Here, beyond denying the third party request to participate in the petition for a filing date proceeding under 37 C.F.R. § 1.53(b), the USPTO should also expunge the third party petition filed on or about January 06, 2009 in order to deter future petitions by this or any other third party seeking to destroy the *ex parte* nature of the applicant's pending petition to obtain a filing date. Applicant further notes the Opposition is a document filed by a person or entity having no standing in this *ex parte* proceeding and one that is prejudicial, misleading, inaccurate, and of no value to the PTO deciding official or the present prosecution file. The file history of application 08/113,955 and its parent or continuing applications are readily available to the PTO deciding official. As such, the Opposition has no relevance to the petition for a filing date. Further, as all facts pertaining to the reasons why this application should be accorded the requested filing date are appropriately before a PTO deciding official, there is no need for suggested decisions, nor suggested rationale for those decisions, by a third party having no standing in the matter.

Because the patent statute (35 U.S.C. § 301) specifically states what submissions by third parties may be placed in the file of a patent, the patent statute implicitly excludes other third party submissions, such as those herein, from being placed, or retained, in this file. Accordingly, the third party's proffered papers should be expunged. *Cf. Ex Parte Chambers et al.*, 20 USPQ 1470 (Comm'r Pat. 1991); *In re Dubno*, 12 USPQ2d 1153 (Comm'r Pat. 1989)(return, without consideration, of third party petition papers opposing a patent term extension request was appropriate in light of "the intent of the statutes and regulations to make patent term extension essentially an *ex parte* proceeding").

CONCLUSION

Applicant requests, for the reasons given above, that the Opposition filed on or about January 06, 2009 be expunged from the file of the above-identified application, and, further, that the petition filed therewith under 37 CFR 1.183 be refused consideration and likewise be expunged.

Applicant further requests that the instant petition remain in the record to hopefully deter any further third party "Oppositions," or any other unwarranted third party intrusions.

To the extent that any filing fees, petition fees or other fees are owed to the Patent Office regarding the above-captioned Application, the Commissioner is authorized to charge such fees to Petitioner's Deposit Account No. 50-2929, making reference to docket number J8300.1.

Dated: February 5, 2009

Respectfully submitted,

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